

This Opinion is not a  
Precedent of the TTAB

Mailed: February 7, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Tiarra Hamlett and Michael Hamlett Jr.*

*v.*

*Bronx Native, composed of Giancarlos Martinez, Roselyn Grullon, Amaurys Grullon*

—  
Cancellation No. 92077944  
—

Katherine J. Daniels, Esq., Katherine Daniels LLC  
for Tiarra Hamlett and Michael Hamlett Jr.

Anthony Matos, Esq., Matos & Psomopoulos PLLC  
for Bronx Native, composed of Giancarlos Martinez, Roselyn Grullon, Amaurys  
Grullon.

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Before Kuhlke, Pologeorgis,<sup>1</sup> and Casagrande,  
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:

Bronx Native, a New York partnership composed of Giancarlos Martinez, Roselyn  
Grullon, Amaurys Grullon (“Respondent”), owns Registration No. 5472676 on the

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<sup>1</sup> Judge Jonathan Hudis, now deceased, participated in the oral hearing of this matter. Judge Pologeorgis is substituted in his place for the purposes of final decision. *See* TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 802.04 (2023); *see also In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985).

Principal Register for the mark BRONX NATIVE, in standard characters, for the following:

Clothing, namely, shirts, hats, hoodies, caps, sweaters, sweatpants, coats, jackets, socks, shirts, blouses, sneakers, sandals, flip flops, pants, wristbands, long sleeve shirts, baseball caps, dresses, tank tops, polo shirts, bath robes, leggings, short sleeve shirts, denim jackets, cardigans, vests, blazers, jerseys, gloves, underwear, socks, bathing suits, shorts, and bandanas, in International Class 25.<sup>2</sup>

Tiarra Hamlett and Michael Hamlett Jr. (“Petitioners”) are petitioning to cancel the registration on the following remaining grounds:<sup>3</sup>

- (1) Respondent had not used its mark BRONX NATIVE in connection with the all of the listed goods at the time it filed its use-based application; and
- (2) Priority and likelihood of confusion under Section 2(d) the Act, 15 U.S.C. § 1052(d).

Petitioners pleaded ownership of Registration No. 5371915 issued on the Supplemental Register of the standard character mark THE BRONX BRAND (BRAND disclaimed),<sup>4</sup> and Registration No. 5205022 issued on the Principal Register

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<sup>2</sup> The registration issued on May 22, 2018, from Application Serial No. 87295218, filed on January 10, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use of November 1, 2015, and first use in commerce of December 1, 2015.

<sup>3</sup> 1 TTABVUE. References to the briefs, other filings in the case, and the record cite the Board’s TTABVUE docket system. The number preceding “TTABVUE” represents the docket number assigned to the cited filing in TTABVUE and any number immediately following “TTABVUE” identifies the specific page(s), if any, to which we refer.

In an order dated December 20, 2022, the Board dismissed Petitioners’ fraud claim because the claim was premised solely on an immaterial allegation that Respondent’s stated date of first use was erroneous but Petitioners acknowledged there was use on some of the goods prior to the application filing date. *See* 12 TTABVUE 4-6. The prior order also “deemed unpled” the grounds of deceptiveness and non-ownership. *Id.* at 2 n.4.

<sup>4</sup> Registration No. 5371915 issued on January 2, 2018, from Application Serial No. 87314076, filed on January 26, 2017, under Section 1(a) of the Trademark Act, 15 U.S.C.

for the design mark ,<sup>5</sup> both of which cover several types of clothing goods in International Class 25. Petitioners also allege that they have priority in the BRONX NATIVE mark and that Petitioners previously opposed the application that matured into Respondent's BRONX NATIVE registration, but that the parties had entered into a written "Coexistence Agreement," pursuant to which Petitioners withdrew the opposition and ceased use of BRONX NATIVE.<sup>6</sup>

Respondent filed an Answer denying the salient allegations in the Petition.<sup>7</sup> Respondent's Answer further asserted two affirmative defenses based on the parties' prior agreement, alleging that Petitioners have waived and forfeited, and that the Agreement estops Petitioners from asserting, the claims Petitioners assert in this proceeding.<sup>8</sup>

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§ 1051(a), alleging a date of first use of July 1, 2015, and date of first use in commerce of July 3, 2015.

<sup>5</sup> Registration No. 5205022 issued on May 16, 2017, from Application Serial No. 87204614, filed on October 16, 2016, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging a date of first use of July 1, 2015, and date of first use in commerce of July 3, 2015.

<sup>6</sup> See 1 TTABVUE 8-10.

<sup>7</sup> See 5 TTABVUE 2-5.

<sup>8</sup> See *id.* at 5-6 ¶¶36-36. Under the heading "Affirmative Defenses," Respondent also includes an allegation that the Petition fails to state a claim upon which relief can be granted. *Id.* at 6 ¶ 37. This is not an affirmative defense. See, e.g., *Shenzhen IVPS Tech. Co. v. Fancy Pants Prods., LLC*, 2022 USPQ2d 1035, at \*3 n.5 (TTAB 2022). Respondent further alleges that it has priority of use and that there is no likelihood of confusion. 5 TTABVUE 6 ¶ 38. These allegations are just amplifications of Respondent's denial of Petitioners' allegations, not an affirmative defense. See, e.g., *Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at \*3-4 (TTAB 2021); see generally *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) ("An affirmative defense is a defendant's assertion raising new facts and arguments that, if true, will defeat the plaintiff's or prosecution's claim, even if all allegations in the complaint are true.") (cleaned up; citation omitted). Respondent also purports to "give notice that [it] may rely on other defenses that may become available or arise during discovery and hereby reserve[s] the right to amend this Answer to assert any such affirmative defenses." 5 TTABVUE 6 ¶ 40. This is neither an affirmative defense nor proper. See *Made*

Petitioners and Respondent each filed trial briefs, and Petitioners filed a reply brief.<sup>9</sup> The Board held a video hearing on December 13, 2023, at which Petitioners' and Respondent's counsel appeared and presented argument.<sup>10</sup>

## I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved registration. In addition, Petitioners introduced the Declaration of Petitioner Michael Hamlett, Jr., together with several exhibits, including:

- The transcript of the discovery deposition of Amaurys Grullon, one of the partners of Respondent Bronx Native;<sup>11</sup>
- A “Coexistence Agreement” between The Bronx Brand, LLC, and Get Studios LLC dba Bronx Native, signed by Michael Hamlett on behalf of The Bronx Brand, LLC, on March 23, 2018, and on behalf of Bronx Native by Amaurys Grullon on March 28, 2018;<sup>12</sup> and
- A TTAB filing entitled “Withdrawal of Opposition” filed on April 10, 2018, in Opposition No. 91235549 encaptioned *The Bronx Brand, LLC v. Bronx Native*, attaching a copy of the aforementioned Coexistence Agreement.<sup>13</sup>

Respondent submitted no evidence during its trial period.

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*in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at \*6 (TTAB 2022) (Applicant's “attempt to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give ... [Applicant] fair notice of such defenses.”) (citations omitted).

<sup>9</sup> See 18 TTABVUE (Petitioners' trial brief); 20 TTABVUE (Respondent's trial brief); 21 TTABVUE (Petitioners' reply brief).

<sup>10</sup> See 27 TTABVUE.

<sup>11</sup> See 15 TTABVUE 31-57.

<sup>12</sup> See *id.* at 58-60.

<sup>13</sup> See *id.* at 61-66.

## II. Statutory Entitlement to Opposition/Cancellation

Before we address anything else in a cancellation or an opposition, we assess whether the governing statute entitles the party bringing the case to have instituted the proceeding. Petitioners instituted this proceeding under Section 14 of the Trademark Act, 15 U.S.C. § 1064. Section 14 authorizes “any person who believes that he is or will be damaged ... by the registration of a mark” to seek cancellation of such registration. To establish their entitlement under Section 14 to seek cancellation of Respondent’s registration, Petitioners must demonstrate: (i) an interest falling within the zone of interests protected by the statute; and (ii) proximate causation. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061 (2014)). Demonstrating a real interest in cancelling a registration satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Id.* at \*7-8.

Here, Petitioners have alleged that they own a registration for THE BRONX BRAND that predates the challenged registration, have prior common law rights in BRONX NATIVE and have alleged a plausible likelihood of confusion claim against the mark in Respondent’s registration, thereby showing that Petitioners have a real interest in petitioning to cancel the registration and a reasonable basis for their belief of damage. *See, e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Entitlement to seek cancellation of this ground entitles

Petitioners to raise any other statutory bar(s) to registration that they deem applicable. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012) (once a party demonstrates entitlement to oppose registration on one ground, it “is entitled to rely on any of the grounds set forth in section 2 of the Lanham Act which negate applicant’s right to its subject registration”) (citations omitted). Thus, Petitioners are entitled to bring this cancellation proceeding.

### III. Preliminary issue

Before we address the merits of the case, we first address an important issue that arose during the trial briefing of the case. In their Reply Brief, Petitioners pointed out discrepancies in three of the citations to decisional law in Respondent’s trial brief. Specifically, Petitioners pointed out that Respondent’s brief cited and purported to quote from *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006), as precedent for the notion that a clear and unambiguous contract controls irrespective of later-discovered facts and that parties cannot take differing positions in cases in different proceedings, but there is no such quote in the decision.<sup>14</sup> Referring to Respondent’s citation of “*E.J. Brach Corp. v. Gilbert/Robinson, Inc.*, 185 USPQ 597 (TTAB 1975)” for the proposition that “agreements are binding and not provisional upon subsequent discoveries,”<sup>15</sup> Petitioners noted that “*E.J. Brach Corp.* has nothing

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<sup>14</sup> *See* 21 TTABVUE 4 n.2 (Petitioners’ Reply) (discussing 20 TTABVUE 8).

<sup>15</sup> *See* 20 TTABVUE 9.

to do with the arguments for which it is cited.”<sup>16</sup> Petitioners also highlighted that Respondent had cited *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) concerning the weight to be given uncorroborated testimony,<sup>17</sup> but Petitioners noted that “[t]here is no such discussion in *Cunningham*.”<sup>18</sup> Our review of Respondent’s trial brief revealed that Petitioners’ observations are correct.

In *Cunningham*, there is no discussion about the weight to be given uncorroborated testimony. Similarly, there is no discussion in *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741 (TTAB 2006), about “clear contractual language”—the topic for which Respondent cites the decision. The quotation appearing in Respondent’s trial brief which Respondent attributes to the cited case appears nowhere in the decision.

Even worse, the case “*E.J. Brach Corp. v. Gilbert/Robinson, Inc.*, 185 USPQ 597 (TTAB 1975)” does not exist. Our research revealed several cases in which E.J. Brach Corp. was a party, but none in which Gilbert/Robinson, Inc., was also a named party. Indeed, we could find no decision of ours in which Gilbert/Robinson, Inc., was a named party.

Our investigation into the discrepancies identified by Petitioners led us to discover that Petitioners’ list of problematic citations in Respondent’s brief is not exhaustive.

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<sup>16</sup> See 21 TTABVUE 4 n.2.

<sup>17</sup> See 20 TTABVUE 8.

<sup>18</sup> See 21 TTABVUE 3 n.1

Respondent purported to quote from “*CEP Holdings, LLC. v. Bieber*, 107 USPQ2d 1402 (TTAB 2013),” on legal principles pertaining to actual confusion evidence.<sup>19</sup> Neither a decision by that name nor any decision at that cite exists. Page 1402 of the USPQ2d reporter encompasses a decision in *iCall, Inc. v. Tribair, Inc.*, 107 USPQ2d 1401 (N.D. Cal. 2012). Neither quotation Respondent attributes to “*CEP Holdings*” appears in the *iCall* decision. Nor could we find any TTAB decision with “CEP Holdings” in the case caption.

Respondent also cites “*U.S. Olympic Committee v. S. Industries plc*, 63 USPQ2d 2001 (TTAB 2002)” for the proposition that the TTAB does not adjudicate breach of contract claims.<sup>20</sup> Neither a decision by that name nor any decision at that cite exists. The reported cite “63 USPQ2d 2001” encompasses a decision captioned *Virtual Countries, Inc. v. Republic of S. Africa*, 300 F.3d 230, 63 USPQ2d 1993 (2d Cir. 2002), which concerns only the issue of whether the Foreign Sovereign Immunities Act of 1976 precludes subject matter jurisdiction over the defendant in that case. Our research revealed several cases in which “S. Industries, **Inc.**” was a party, but none where “S. Industries, **plc**,” was a party. And while we have adjudicated many cases in which the U.S. Olympic Committee was a party, none involved a party named “S. Industries.”

Respondent’s trial brief further cites *Union Carbide Corp. v. Ever-Ready Inc.*, 531 F.2d 366, 188 USPQ 623 (7th Cir. 1976)—a decision well-known to practitioners of

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<sup>19</sup> See 20 TTABVUE 10.

<sup>20</sup> See 20 TTABVUE 15.

trademark law—arguing that it “emphasized that agreements that are clear in their intent should be upheld even in the face of potential misrepresentation, especially when both parties clearly understand the subject matter and implications of the agreement.”<sup>21</sup> The *Union Carbide* decision discusses many issues, but the effect of misrepresentations on the interpretation or validity of agreements is not among them. In fact, there is no mention at all in the decision of any agreement or contract.

Respondent cites “*Beck v. Manufacturers Hanover Trust Co.*, 98 A.D.2d 8, 469 N.Y.S.2d 14 (1983)” with the parenthetical “(recognizing a partner’s inherent authority to bind the partnership).”<sup>22</sup> We could not find that decision. The decision listed at 98 A.D.2d 8 is *City of Rochester v. Chiarella*, 98 A.D.2d 8, 470 N.Y.S.2d 181 (1983). The decision listed at 470 N.Y.S. 2d 14 is *People v. Gordon*, 98 A.D.2d 781, 470 N.Y.S.2d 14 (1983). We located a 1995 New York decision encaptioned “*Beck v. Manufacturers Hanover Trust Co.*,” but it is reported at 218 A.D.2d 1, 632 N.Y.S.2d 520, and has nothing to do with a partner’s authority to bind a partnership.

At oral argument, we asked counsel for Respondent how he had identified these case citations. He responded that he had used the Internet, elaborating that he had performed searches on Google resulting in identification of blog posts and articles discussing these decisions. When we followed up by asking whether he had read the decisions he purported to identify in that manner, he admitted that he had not. He explained that his law practice does not have access to the case reporters in question.

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<sup>21</sup> See 20 TTABVUE 14-15.

<sup>22</sup> See 20 TTABVUE 14.

Our agency's rules provide that "[b]y presenting to the Office ... any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law." 37 C.F.R. § 11.18(b)(2)(ii). Fed. R. Civ. P. 11, which applies to Board proceedings pursuant to Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), contains substantively identical terms. This obligation is related to that in 37 C.F.R. § 11.303, which is entitled "Candor toward the tribunal." That rule provides, in pertinent part that "[a] practitioner shall not knowingly ... [m]ake a false statement of ... law to a tribunal or fail to correct a false statement of ... law previously made to the tribunal by the practitioner ...."<sup>23</sup>

Respondent's counsel did not comply with the basic, critical obligations set forth in the rules quoted above. Failing to read the decisions cited in a trial brief represents a dereliction of the duty to perform "an inquiry reasonable under the circumstances" sufficient to certify that the "legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law." Attributing propositions of law to decisions that did not discuss those propositions is bad enough. Purporting to actually quote from

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<sup>23</sup> See also Feb. 6, 2024, Director guidance on party and practitioner misconduct related to the use of AI (<https://www.uspto.gov/sites/default/files/documents/directorguidance-aiuse-legalproceedings.pdf> (accessed Feb. 6, 2024)).

decisions where neither the quote nor anything like it appears is worse. And worst of all is citing or purporting to quote from decisions **that do not exist**.

That a private law office may not have bound law reporters or a subscription to an electronic version legal search tool that would provide access to law reporters is no excuse for failing to read reported decisions that are cited to the tribunal as legal authority. We take judicial notice that each county in New York, where Respondent's counsel's office is located, is required to maintain a public access law library, and that<sup>24</sup> the Manhattan Public Access Law Library located at 80 Centre Street, Room 242, has Westlaw and Lexis electronic search access.<sup>25</sup> *See, e.g., United States v. Garcia*, 855 F.3d 615, 621 (4th Cir. 2017) ("This court and numerous others routinely take judicial notice of information contained on state and federal government websites.") (citations omitted).<sup>26</sup>

The conduct outlined above is not only contrary to the rules sets forth above, but also represents a failure to perform this core duty in the practice of law. The Board, like other tribunals and courts in the adversary system of justice used in this country, rely on counsel to frame the issues for decision. Representing that cited decisions stand for legal propositions not implicated in the decisions undermines the decisional

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<sup>24</sup> *See* <https://ww2.nycourts.gov/lawlibraries/publicaccess.shtml> (accessed Jan. 31, 2024).

<sup>25</sup> *See* [https://ww2.nycourts.gov/library/nyc\\_criminal/index.shtml#:~:text=The%20library%20is%20located%20at,the%20Federal%20and%20State%20Courts](https://ww2.nycourts.gov/library/nyc_criminal/index.shtml#:~:text=The%20library%20is%20located%20at,the%20Federal%20and%20State%20Courts) (accessed Jan. 31 2024).

<sup>26</sup> We further note that the second-listed search result from a Google search for "Starbucks U.S. Brands, LLC v. Ruben, 78 USPQ2d 1741 (TTAB 2006)" was a reprint of the official USPTO decision, in slip opinion form, in the free "Casetext" database appearing at the URL <https://casetext.com/admin-law/starbucks-us-brands-llc-and-starbucks-corporation-v-marshall-s-ruben> (checked on December 18, 2023).

process. And we are at a loss for words that adequately express the gravity of Respondents' citation of fictitious decisions.

Petitioners' October 2, 2023, reply brief put Respondent's counsel on notice that Respondent's brief contained problematic "legal" citations. In the more-than-two-month period between the submission of Petitioners' reply brief and the December 13, 2023, oral hearing, Respondent did not seek to explain or even request to rectify these citations. And in response to our questions at the oral hearing about these citations, Respondent's counsel admitted that he did not read the cited decisions or even attempt to look up the decisions, including the fictitious ones. Under these circumstances, we consider Respondent to have had "notice and reasonable opportunity to respond" to the allegations that Respondent's brief did not satisfy the governing rules. We therefore strike Respondent's brief. However, we do not consider this a forfeiture of Respondent's defenses, and leave Petitioners to their burden to prove their case.

#### IV. Petitioners' claims

Turning to the merits of the case, we begin with Respondent's affirmative defense that the March 18, 2018, Coexistence Agreement estops Petitioners from challenging Respondent's registration for BRONX NATIVE.<sup>27</sup> If we find that the agreement

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<sup>27</sup> While Respondent's Answer uses the terms "forfeited" and "waiver and equitable estoppel," *see* 5 TTABVue 5 (¶¶ 35 & 36), the balance of the paragraphs in question specifically discuss the legal effect of the Coexistence Agreement on Petitioners' right to bring and prosecute this proceeding, thereby putting Petitioners on notice that these defenses concern the effect of the Agreement. Therefore, Respondent's failure to use the more common term "contractual estoppel" is of no moment.

estops Petitioners from pursuing this case, we need not address Petitioners' fraud claim or the claims brought under Sections 1(a) and 2(d) of the Trademark Act, 15 U.S.C. §§ 1051(a) & 1052(d).

Our primary reviewing court has made clear that the Board has authority to entertain an opposition to an application based on an agreement barring registration of the opposed mark and to entertain a defense that a prior agreement might either preclude a party from opposing an application or challenging a registration. *See Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 38 (Fed. Cir. 1985) ("In the instant case, the issue is whether a mark otherwise entitled to registration is, nevertheless, barred therefrom by an agreement between the parties. We hold that this issue is within the jurisdiction of the board and may constitute an independent basis for sustaining the opposition apart from the issue of likelihood of confusion."); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983) (remanding to the Board to determine whether settlement agreement ending prior opposition precluded opposer from opposing the mark at issue). Under this authority, the Board may consider and construe an agreement, or determine its validity, but may not entertain claims for enforcement or breach of the agreement. *See Selva & Sons*, 217 USPQ at 647; *see also Hu v. TJ Food Serv., LLC*, 123 USPQ2d 1777, 1779 (TTAB 2017); *Bausch & Lomb Inc. v. Karl Storz GmbH*, 87 USPQ2d 1526, 1530 (TTAB 2008); *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1791 (TTAB 2006); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2013 (TTAB 2002); *M-5 Steel Mfg., Inc. v. O'Hagin's*

*Inc.*, 61 USPQ2d 1086, 1094-95 (TTAB 2001). Claims for enforcement, breach, or rescission belong in courts of appropriate jurisdiction. *See, e.g., Selva & Sons*, 217 USPQ at 647; *Hu*, 123 USPQ2d at 1779; *Bausch & Lomb*, 87 USPQ2d at 1530.

As mentioned, Petitioner Michael Hamlett Jr. appended a copy of the Coexistence Agreement to his declaration.<sup>28</sup> Pertinent excerpts from the agreement appear below:

#### COEXISTENCE AGREEMENT

THIS AGREEMENT is made by and between THE BRONX BRAND, LLC, (hereinafter “BB”) having a place of business at 277 E. 240<sup>th</sup> Street, Bronx, NY 10470 and GET STUDIOS LLC dba BRONX NATIVE, (hereinafter “BN”) having a place of business at 783 Southern Boulevard, # 2D, Bronx, NY 10455, each a “Party” and collectively the “Parties”. The Effective Date of this Agreement shall be the later date of signature set forth below.

WHEREAS, BB has a registered trademark on the Supplemental Register for “THE BRONX BRAND” under Registration No. 5,371,915 with the United States Patent and Trademark Office (hereinafter “USPTO”), covering a variety of goods in International Class 25.

WHEREAS, BN has a pending trademark application for “BRONX NATIVE” under Serial No. 87295218 with the USPTO, covering a variety of goods in International Class 25.

WHEREAS, on July 12, 2017, BB filed a Notice of Opposition with the USPTO Trademark Trial and Appeal Board under Proceeding No. 91235549 against BN on the grounds of priority and likelihood of confusion.

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<sup>28</sup> *See* 15 TTABVUE 5 ¶ 22 (declaration); *id.* at 57-59 (copy of agreement).

NOW THEREFORE, in consideration of the recitations, mutual promises, and covenants set forth in this Agreement; and for other good and valuable consideration, the receipt and sufficiency of which are acknowledged, the Parties agree to the following:

1. BN acknowledges BB's intellectual property rights to "THE BRONX BRAND" mark and it will not challenge or interfere with BB's use of such mark in connection with any goods covered in International Class 25.
2. BB acknowledges BN's intellectual property rights to the "BRONX NATIVE" mark and it will not challenge or interfere with BN's use or registration of such mark in connection with any goods covered in International Class 25.

\* \* \*

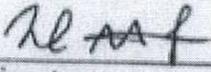
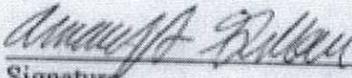
7. Within ten (10) business days from the Effective Date herein, BB agrees to withdraw the above referenced Notice of Opposition against BN under Proceeding No. 91235549, by filing or allowing to be filed the appropriate request with the USPTO.
8. The Parties are aware that a fully executed copy of this Agreement will be filed with the USPTO for the purpose of terminating the above referenced opposition proceeding.

\* \* \*

10. The terms of this Agreement shall be limited to the United States and is binding on the Parties, their affiliates, related companies, successors and assigns.
11. This Agreement sets forth the entire Agreement between the Parties and supersedes any and all prior agreements or understandings, oral or written, concerning the subject matter of the Agreement. The terms of this Agreement may only be modified in writing signed by both Parties.
12. The Parties acknowledge that this Agreement was fairly negotiated with the opportunity to seek consultation or negotiate the terms of this Agreement. No part of this Agreement is to be construed against either party because of the identity of the drafter.

\* \* \*

IN WITNESS WHEREOF, the Parties hereto have caused this Agreement to be executed by their duly authorized representatives as of the day and year first above written.

THE BRONX BRAND, LLC	BRONXNATIVE
 _____ Signature	 _____ Signature
MICHAEL D. HAMLETT Name (print)	Amaury Grullon Name (print)
MANAGING MEMBER Title	Chief Executive Officer Title
03/23/18	5/28/19

The Petition alleges that Petitioners Tiarra Hamlett and Michael Hamlett Jr. are the sole members of The Bronx Brand LLC,<sup>29</sup> which is a party to the agreement. The other party is “Get Studios LLC dba Bronx Native,” and the document is signed by Amaury Grullon on behalf of Bronx Native. The Respondent and owner of the challenged registration here is Bronx Native, a New York partnership composed of Giancarlos Martinez, Roselyn Grullon, Amaury Grullon. The agreement abbreviates the names of the parties as “BB” and “BN,” respectively and BN is attributed as having the underlying application for BRONX NATIVE Serial No. 87295218 for the subject registration. We find the agreement, read in its totality, binds the parties in this case.

Paragraph 2 of the agreement provides: “BB acknowledges BN’s intellectual property rights to the ‘BRONX NATIVE’ mark and it will not challenge or interfere

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<sup>29</sup> See 1 TTABVUE 7.

with BN's use or registration of such mark in connection with any goods covered in International Class 25." This provision plainly applies to the challenged registration here, and if given its natural effect, precludes this Petition. Petitioners do not contend otherwise. And Petitioners point to no other provision of the agreement that extricates them from their agreement to "not challenge ... BN's ... registration" for BRONX NATIVE.

Instead, Petitioners argue that the agreement is "null and void" because Respondent, through its counsel in the prior opposition proceeding, made several alleged misrepresentations on which Petitioners relied which induced Petitioners to enter into the agreement.<sup>30</sup> This is essentially a claim that the agreement, by virtue of having been induced by fraud, is thereby unenforceable against the party accused of misrepresentations. *See, e.g., John v. Elefante*, 210 A.D.3d 666, 668, 177 N.Y.S.3d 649, 652 (2022) ("A contract induced by fraud is subject to rescission, rendering it unenforceable by the culpable party.") (citations omitted). "The equitable remedy of rescission is only to be invoked where the plaintiff has no adequate remedy at law and where the parties can be substantially restored to their status quo ante positions." *Habberstad Volkswagen, Inc. v. GC Volkswagen, Inc.*, 127 A.D.3d 1019, 1020, 7 N.Y.S.3d 463, 464 (2015). Adjudication of this sort of claim, however, is beyond our limited statutory authority. *Cf. Selva & Sons*, 217 USPQ at 647 ("courts would be the proper tribunals in which to litigate a cause of action for enforcement or

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<sup>30</sup> *See* 18 TTABVUE 6-7.

breach of the contract”). That being the case, we hold that Petitioners are contractually estopped from challenging Respondent’s BRONX NATIVE registration.

V. Conclusion

Petitioners’ claims for cancellation are precluded by contractual estoppel. We therefore need not address the merits of those claims.

**Decision:** The Petition to Cancel is denied.